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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/081,417	02/22/2002	Rodney G. Moon	CHA920010020US1	1023

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EXAMINER

MACKOWEY, ANTHONY M

ART UNIT PAPER NUMBER

2623

DATE MAILED: 11/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b>	<b>Application No.</b> 10/081,417	<b>Applicant(s)</b> MOON ET AL.	
	<b>Examiner</b> Anthony Mackowey	<b>Art Unit</b> 2623	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 02 November 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
 b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
 (b) ☐ They raise the issue of new matter (see NOTE below);  
 (c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
 5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
 6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
 The status of the claim(s) is (or will be) as follows:  
 Claim(s) allowed: \_\_\_\_\_.  
 Claim(s) objected to: \_\_\_\_\_.  
 Claim(s) rejected: 1-22.  
 Claim(s) withdrawn from consideration: \_\_\_\_\_.

#### AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
 12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_  
 13. ☐ Other: \_\_\_\_\_.

JINGGE WU  
 PRIMARY EXAMINER

Continuation of 11. does NOT place the application in condition for allowance because: Applicant's arguments filed November 2, 2005 have been fully considered but they are not persuasive.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., MICR format character data has the equivalent specification of data obtained by a multigap MICR read head) are not recited in the rejected claim(s) 1, 8 and 21. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

On page 8, lines 6-14) applicant presents arguments regarding claims 1, 8, 15, and 21, reciting "Please note, in the claimed invention, a MICR format character data 'has the equivalent specifications of data obtained by a multigap MICR read head.'" (See specification of the claimed invention at page 6, lines 9-10; see also claim 15)." Claim 15 is the only independent claim to such a similar limitation, "means for converting the character data to a spatial resolution and density as if captured by a Magnetic Ink Character Recognition (MICR) read head." However, such a limitation is not recited in claims 1, 8 or 21. Dependent claims 4, 11 and recite similar limitations regarding "scaling the character data to a pel density associated with a multigap MICR read head."

On page 8, lines 14-19, applicant argues, "the stored MICR fonts in Simonoff are not MICR format character data because the stored MICR fonts do not have the equivalent specifications of data obtained by a multigap MICR read head." Examiner respectfully disagrees that the MICR fonts are not MICR format character data. On page 9, lines Examiner further indicates applicant has argued Simonoff alone and has not addressed the combinations of Simonoff with Kruppa, Higgins, and Tatieshi. The MICR data taught by combinations as described in the previous Office Actions clearly teach the limitations describing the MICR format character data claimed by the applicant (i.e. the scaling and black and white image format).

Applicant's arguments presented on page 9, lines 1-11 again argues Simonoff independently and does not take into account the rejection was based on combination of the teachings of Simonoff and Kruppa. Regarding applicant's suggestion that the Examiner has made an over-broad interpretation and the "MICR format character data" as used in the claimed invention does not include "printed MICR font character," it is respectfully submitted that the Examiner is entitled to the broadest reasonable interpretation of the claims (see MPEP 2111) and that the current claim language does not preclude the converted character data from being printed before a recognition engine such as that taught by Kruppa.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Simonoff seeks to "provide a negotiable instrument based on the originally inputted graphic image" (col. 2, line 67 - col. 3, line 2). The facsimile image alone cannot be used as a negotiable instrument. It cannot be deposited at a bank. The printed document taught by Simonoff can be used as a negotiable document and deposited at the recipient's bank (col. 3, lines 50-53). The goal of Simonoff is to produce negotiable instruments that can be deposited at banks. It is well known banks employ recognition engines in check settlement processing and it is therefore obvious to use a recognition engine as taught by Kruppa to process the negotiable instrument as taught by Simonoff. Applicant further argues that "Simonoff and Kruppa are not combined in a manner to reach and suggest all features of the claimed invention." Examiner respectfully disagrees. Although the combination does not teach the invention as explicitly described in the specification it does teach the current claim limitations as reasonably interpreted by the Examiner. In response to applicant's allegation presented on page 9, lines 21-23, the Examiner has clearly indicated in the previous Office Action (i.e. page 5, line 14 - page 6, line 5), the combination as presented does teach interpreting the converted character data.

AM  
11/16/2005